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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/069,463	02/26/2002	Wilma M Dausch	50683	3250

7590 12/07/2004

Keil & Weinkauff
1350 Connecticut Ave., NW
Washington, DC 20036

EXAMINER

PENG, KUO LIANG

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 12/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/069,463

Applicant(s)

DAUSCH ET AL.

Examiner

Kuo-Liang Peng

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11/1/04 Amendment.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9, 11-26 and 29-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9, 11-26 and 29-36 is/are rejected.
- 7) ☒ Claim(s) 9, 11-22, 32-33, 35-36 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 1, 2004 has been entered. Claims 17, 24, 30 and 35 are amended. Claims 27-28 are deleted. Now, Claims 9, 11-26 and 29-36 are pending.

2. The indicated allowability of Claims 17 and 35 is withdrawn in view of the new ground of rejection. Rejections based on the new ground follow. Examiner apologizes for any inconvenience.

Claim Objections

3. Claims 9, 11-22, 32-33 and 35-36 are objected to because of the following informalities:

In Claim 9 (line 3), should "and" be deleted?

In Claim 35, the claim identifier “(previously presented)” should be --
(Currently amended) --.

Appropriate correction is required.

4. The text of those sections of Title 35, U.S. code not included in this action can be found in a prior Office Action (Paper No. 0104).

Claim Rejections - 35 USC § 102

5. Rejection of Claims 24-26 and 29-31 under 35 USC 102(e) as being anticipated by Beckham (US 6 191 215) is maintained because the rejection is adequately set forth in paragraph 3 of Paper No. 0104. Applicant's arguments have been fully considered but they are not persuasive. The focus argument related to the core patentability is discussed below.

Applicants primarily argue that “Beckham et al. does not disclose polymers obtained by the free-radical polymerization of *tert*-butyl and/or methacrylic acid in the presence of polyalkylene oxide containing silicones of the formula I, as presently claimed.” (Remarks, 2nd paragraph) Applicants should notice that Component a) can be the monomers such as methacrylic acid and/or *t*-butyl

acrylate, etc. and Component b) can be a copolymer of formula (I) or (II). (col. 1, line 55 to col. 2, line 19, col. 5, lines 1-10 and col. 7, lines 22-42).

6. When a UV light protection filter is not present, Claim 35 is rejected below.

7. Claim 35 are rejected under 35 U.S.C. 102(e) as being anticipated by Beckham.

Beckham discloses a pharmaceutical preparation, supra, which is incorporated herein by reference. It is noted that Beckham's preparation reads on the pharmaceutical preparation of the instant claims where a UV light protection filter is not necessarily present.

Claim Rejections - 35 USC § 103

6. Rejection of Claims 9, 11-16, 18-23, 32-34 and 36 under 35 USC 103(a) as being anticipated by Beckham, in view of Sramek (US 4 871 529) and Habeck (JP 10-158140) is maintained because the rejection is adequately set forth in paragraph 5 of Paper No. 0104. Applicant's arguments have been fully considered but they are not persuasive. The focus argument related to the core patentability is discussed below.

Applicants primarily argue that the use of the copolymer derived from *t*-butyl acrylate and methacrylic acid in the presence of [polyalkylene] oxide containing silicones in the present invention (i.e., Claim 9) has an unexpected good result over the use of polyvinylactam polymers alone. (Remarks, page 2, 4th paragraph to page 3, 2nd paragraph) However, Applicants should notice that first of all, Claim 9 does not limited to the copolymer derived from *t*-butyl acrylate and methacrylic acid in the presence of polyalkylene oxide containing silicones. Secondly, the aforementioned unexpected result is irrelevant because Claim 9 is not limited to the use of polyvinylactam polymers only. Thirdly, the copolymers used for showing the unexpected result are limited to those copolymers derived from *t*-butyl acrylate, methacrylic acid, ethyl acrylate and *t*-butyl perpivalate in the presence of polyalkylene oxide containing silicones (Examples 1-6), rather than copolymers derived from only *t*-butyl acrylate and methacrylic acid in the presence of polyalkylene oxide containing silicones. In other words, there is no evidence that formation of poly(*t*-butyl acrylate-co-methacrylic acid) in the presence of polyalkylene oxide containing silicones will result in the same unexpected result. Fourthly, as indicated in Applicants Remarks, the unexpected good results are solely demonstrated between a preparation containing Luviflex Silk and polyvinylactam polymers and a preparation containing polyvinylactam polymers

alone. There is no evidence of unexpected result based on a preparation containing Luviflex Silk and other polymers claimed in the present invention and a preparation of these "other polymers" alone.

7. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Beckham in view of Sramek and/or Habeck.

Beckham discloses a pharmaceutical preparation, *supra*, which is incorporated herein by reference. The rejection recited in paragraph 5 of the previous Office (Paper No. 0104) action applies. Note that Habeck also teaches the use of a UV filter in a pharmaceutical preparation. (Abstract)

8. When a UV light protection filter is present, Claim 35 is rejected below.

9. Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Beckham in view of Habeck.

Beckham discloses a pharmaceutical preparation, *supra*, which is incorporated herein by reference. Beckham is silent on the specific use of a UV filter. However, it is well known in the art to incorporate a UV filter in a pharmaceutical preparation as taught by Habeck. The motivation of incorporating a

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UV filter is to protect human skin or human hair from sunlight. (Abstract) In light of the benefit mentioned, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to incorporate a UV filter into Beckham's preparation.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuo-Liang Peng whose telephone number is (571) 272-1091. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski, can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair->


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klp

December 3, 2004

Kuo-Liang Peng
Primary Examiner
Art Unit 1712


KUO-LIANG PENG
PRIMARY EXAMINER